



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,250	03/04/2002	David F. Sorrells	1744.0140006	1369

26111 7590 12/20/2004

STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

BHATTACHARYA, SAM

ART UNIT	PAPER NUMBER
----------	--------------

2687

DATE MAILED: 12/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/086,250

Applicant(s)

SORRELLS ET AL.

Examiner

Sam Bhattacharya

Art Unit

2687

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-46 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2-6, 8, 9, 11-17, 19-25, 27-35 and 37-46 is/are rejected.
- 7) ☒ Claim(s) 7, 10, 18, 26 and 36 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20041210</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 2-5, 8 11-16, 19-24, 31-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Tawil et al. (US 6,208,636 B1).

Regarding claims 2, 8, 11, 24, 27, 32, 37, 42 Tawil et al. disclose a telephone, including a down-converter including a switch 16; a storage device 47 coupled to the switch; and a control signal generator 43 coupled to the switch. See FIG. 1 and col. 2, line 63 – col. 3, line 4.

Regarding claims 3-5, 33-35, Tawil et al. disclose the use of the down-converter in a satellite environment and wireless systems which include cellular and cordless communications. See col. 1, line 62 – col. 2, line 9.

Regarding claim 16, Tawil et al. disclose that the down-converter can be used with a computer system. See col. 3, lines 14-18.

Regarding claims 12-15, Tawil et al. disclose that the down-converter is used in conjunction with various networks, such as wireline and wireless local and wide area networks, since telephones and TVs are part of such systems as cable networks and PSTNs.

Claim 19 incorporates the limitations of claims 11 and 16, and is therefore rejected for the same reasons as claims 11 and 16.

Claims 20-23 depend from claim 16 and correspond to claims 12-15, respectively, and are therefore rejected for the same reasons as these claims.

Claims 28-31 depend from claim 24 and correspond to claims 12-15, respectively, and are therefore rejected for the same reasons as these claims.

Claims 38-41 depend from claim 37 and correspond to claims 12-15, respectively, and are therefore rejected for the same reasons as these claims.

Claims 43-46 depend from claim 42 and correspond to claims 12-15, respectively, and are therefore rejected for the same reasons as these claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 6, 9, 17 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tawil et al.

Regarding claims 6 and 9, Tawil et al. fails to explicitly disclose that the down-converter is a portion of a transceiver.

However, it is very well known in the art to use a down-converter as a portion of a transceiver. It would have been obvious to one of ordinary skill in the art to modify the telephone of Tawil et al. by using the down-converter as a portion of a transceiver so that that the down-converted signals can be transmitted after processing is performed.

Claim 17 incorporates the limitations of claims 6 and 16, and is therefore rejected for the same reasons as claims 6 and 16.

Claim 25 incorporates the limitations of claims 6 and 24, and is therefore rejected for the same reasons as claims 6 and 24.

Allowable Subject Matter

6. Claims 7, 10, 18, 26 and 36 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record fails to disclose a combination of elements or steps, including an up-converter including a second switch coupled to a bias signal and a control signal, as in claims 7, 10, 18, 26, 36.

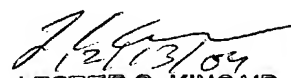
Art Unit: 2687

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Bhattacharya whose telephone number is (703) 605-1171. The examiner can normally be reached on weekdays 8:30 a.m. to 6:00 p.m., first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester G. Kincaid can be reached on (703) 305-3016. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sb


12/13/09
LESTER G. KINCAID
PRIMARY EXAMINER